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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,170	12/01/2003	Steven M. Schein	ST-027 Cont	2063

75563 7590 07/09/2008

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PATENT DOCKETING 39/361
1211 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8704

EXAMINER	
IDOWU, OLUGBENGA O	
ART UNIT	**PAPER NUMBER**
2623	

MAIL DATE	DELIVERY MODE
07/09/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/725,170	SCHEIN ET AL.	
	Examiner	Art Unit	
	OLUGBENGA O. IDOWU	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 March 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 3/10/2008 have been fully considered but they are not persuasive.

In response to applicant's arguments on page 4 paragraph 1 of the remarks about Hendricks not teaching a function related to tagged programs that are activated without a viewer's intervention; as was clearly stated in the office action, Hendricks teaches displaying suggested programs without user intervention in col. 30, lines 47 - 50.

Since Hendricks teaches the system operating without user intervention, Levine was brought in for its teaching on recording. Hashimoto is also brought in for its teaching on reserving television programs.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1 – 20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 -14 of U.S. Patent No. 6 732 369 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant and copending applications discuss the same concept of searching for and tagging programs that are relevant to user.

For example, note the following relationship between the instant application claims and co-pending applications claims:

Claims 1 and 8 of the instant application corresponds to claims 1, 2, 9, 10, 17 and 18 of the copending application.

Claims 2 and 9 of the instant application corresponds to claim 3, 11 and 19 of the copending application

Claims 3 and 10 of the instant application corresponds to claim 4, 12 and 20 of the copending application

Claims 4 and 11 of the instant application corresponds to claim 5 and 13 of the copending application

Claims 5 and 12 of the instant application corresponds to claim 6 and 14 of the copending application

Claim 6 and 13 of the instant application corresponds to claim 7 and 15 of the copending application

Claim 7 and 14 of the instant application corresponds to claim 8 and 16 of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1 – 4, 9 – 12 and 17 - 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Hendricks, patent number: 5 798 785.

As per claims 1, 9 and 17, Hendricks teaches an interactive electronic program guide (IPG) including a display screen comprising:

a database local to a viewer for storing television schedule information including information about television programs and a plurality of criteria associated with each

television program (database on STB storing abstracts, col. 30, lines 40 – 50, lines 10 - 13); and

a microprocessor local to the viewer(microprocessor, col. 9, line 66) configured to automatically generate a set of favorite criteria about television programs that the viewer would likely be interested in (the STB understanding the user and creating a profile, col. 29, lines 26 - 37), search the database for identifying a television program that includes at least one of the favorite criteria (searching the database, col. 30, lines 43 - 44), tag the identified television program stored in the local database that includes the at least one of the favorite criteria (selecting programs, col. 30, lines 47 - 49), and activate a function of the IPG related to the tagged television program without viewer's intervention (displaying a list of suggested programs to viewer, col. 30, lines 48 - 50).

As per claims 2, 10 and 18, Hendricks teaches further comprising a display controller for automatically displaying on the display screen a portion of the schedule information including the identified television program in guide format (displaying a list of suggested programs to viewer, col. 30, lines 48 - 50).

As per claims 3, 11 and 19, Hendricks teaches wherein the favorite criteria includes one or more of actor's name (actor, col. 30, line 55), director's name, type of program, other broadcast times, other broadcast sources, and program theme.

As per claims 4, 12 and 20, Hendricks teaches wherein the microprocessor is configured to monitor and store the viewer's selections of television programs, and heuristically learn the viewer's favorite criteria according to the viewer's selections of television programs (the STB understanding the user and creating a profile, col. 29, lines 26 - 37).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 5, 6, 8, 13, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks, patent number: 5 798 785 in view of Levine, patent number: 5 692 214.

As per claim 5 - 6 and 13 - 14, Hendricks teaches a system that selects and presents programs that a user might like.

Hendricks does not teach a system where the tagged program is automatically tuned to.

In an analogous art, Levine teaches wherein the activated function is automatically programming a recording device to record the tagged television program at scheduled telecast time (automatic recording, col. 4, lines 18 – 31, 40 - 45).

Therefore, it would have been obvious to one of ordinary skill in the art to modify Hendricks' selection system by including an automatic recording system as described in Levine for the advantages of unattended recording, and compensating for changes in recording schedule.

As per claims 8 and 16, Hendricks teaches a system that selects and presents programs that a user might like.
Hendricks does not teach a system that downloads the tagged program.
In an analogous art, Levine teaches wherein the activated function is automatically downloading a copy of the tagged television program to a digital storage medium at scheduled telecast time (Levine: automatic recording, col. 4, lines 18 – 31, 40 – 45, Hendricks: digital signals, col. 6, line 8).

Therefore, it would have been obvious to one of ordinary skill in the art to modify Hendricks' selection system by including an automatic recording system as described in Levine for the advantages of unattended recording, and compensating for changes in recording schedule.

8. Claims 7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks, patent number: 5 798 785 in view of Hashimoto, patent number: 5 179 439.

As per claims 7 and 15, Hendricks teaches a system that selects and presents programs that a user might like.

Hendricks does not teach a system that automatically reminds the viewer of a tagged program.

In an analogous art, Hashimoto teaches wherein the activated function is automatically reminding the viewer to view the tagged television program (alert, col. 6 lines 19 - 26).

Therefore, it would have been obvious to one of ordinary skill in the art to modify Hendricks' selection system by including a reminder system as described in Levine for the advantages of watching the program live or watching and recording the program.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLUGBENGA O. IDOWU whose telephone number is (571)270-1450. The examiner can normally be reached on Monday to Friday, 7am - 5pm Est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Pendelton can be reached on 571 272 7527. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Olugbenga O Idowu/
Examiner, Art Unit 2623

/Brian T. Pendleton/
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